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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/620,617	07/21/2000	Terry A. Smith	10991929-1	4729

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EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/620,617	Applicant(s) SMITH ET AL.	
	Examiner CHAN S PARK	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,8,10-14,18-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8,10-14,18-20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 10/15/04, and has been entered and made of record. Currently, **claims 1, 5, 6, 8, 10-14, 18-20 and 22-25** are pending.

Response to Arguments

2. Applicant's arguments, see pages 6-8, filed 10/15/04, with respect to the rejections of claims 1, 5, 6, 8, 10-14, 18-20 and 22-25 under 35 U.S.C. § 102(e) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Suzuki et al. U.S. Patent No. 5,923,013 (hereinafter Suzuki).

Claim Objections

3. Claim 14 is objected to because of the following informalities: Perhaps "a command" should be added before "indicating new video data". Appropriate correction is required.

4. Claim 20 is objected to because of the following informalities: Perhaps the claim should be amended as "the plurality of commands forms a print job". Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. Claim 25 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The terminology "Printer firmware including programming" alone has no set definition.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11 and 12 recite the limitation "the plurality of commands". There is insufficient antecedent basis for this limitation in the claim. For the examining purposes, Examiner construes the term as "the named sequence and the associated parameter".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 8, 10-14 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki.

7. With respect to claim 1, Suzuki discloses a printer, comprising:

an I/O port (acceptance module 76 and col. 9, line 67 – col. 10, line 5) capable of receiving a plurality of commands describing a document (print job 10 and JDF in fig. 4), the commands including both a named sequence (print job) describing a form and an indicator (JobSave 54 and RipFileSave 56 fields & col. 12, lines 10-27); and

means for responding to the indicator indicating permission is granted to print each instance of the form from the same video data (RipFileSave 56) by processing and printing the named sequence according to a first printing algorithm (printing the print job from the already-expanded print jobs) and for responding to the indicator indicating each instance of the form is to be printed from a new video data (JobSave 54) by processing and printing the named sequence according to a second printing algorithm (printing the print job from the newly rasterized print job).

8. With respect to claim 5, Suzuki discloses the printer of claim 1, wherein the plurality of commands are received from a computer (remote system) externally connected to the I/O port (114 in fig. 12 and col. 9, lines 67-68).

9. With respect to claim 6, Suzuki discloses the printer of claim 5, wherein the indicator is generated by the computer (col. 7, lines 21-23 & lines 44-53).

10. With respect to claim 8, Suzuki teaches a method of processing and printing a named sequence describing a form in a printer, comprising:

receiving the named sequence (print job 10 and JDF in fig. 4) and an associated parameter (JobSave 54 and RipFileSave 56 fields & col. 12, lines 10-27);

responding to the parameter being set to a first value (RipFileSave 56), indicating permission is granted to print each instance of the form from the same video data (the already-expanded print jobs), by converting (ripping or rasterizing) the named sequence into video data (expanded) and then using the video data to print each instance of the form; and

responding to the parameter being set to a second value (JobSave 54), indicating that each instance of the form is to be printed from new video data (newly expanded/ripped print jobs), by generating new video data (rasterized) to print each instance of the form.

11. With respect to claim 10, Suzuki teaches a method of processing and printing a named sequence describing a form in a printer, comprising:

- a. receiving the named sequence (print job 10 and JDF in fig. 4) and an associated parameter (JobSave 54 and RipFileSave 56 fields & col. 12, lines 10-27);
- b. responding to the parameter being set to a first value (RipFileSave 56), indicating permission is granted to print each instance of the form from the same video data (the already-expanded print jobs), by converting (ripping or rasterizing) the named sequence into video data (expanded) and then using the video data to print each instance of the form; and
- c. responding to the parameter being set to a second value (JobSave 54), indicating each instance of the form is to be printed from new video data (newly expanded/ripped print jobs), by converting the named sequence into display list

data (S201) and then using the display list data to print each instance of the form (S202 in fig. 17).

12. With respect to claim 11, Suzuki teaches the method of claim 8, wherein the named sequence and the associated parameter are received from a source externally connected to the printer (fig. 1; col. 7, lines 21-23; & lines 44-53).

13. With respect to claim 12, Suzuki teaches the method of claim 10, wherein the named sequence and the associated parameter are received from a source externally connected to the printer (fig. 1; col. 7, lines 21-23; & lines 44-53).

14. With respect to claim 13, Suzuki teaches the method of claim 12, wherein step (c) comprises the following substep:

flagging the display list data as a candidate for caching (col. 12, lines 10-27).

15. With respect to claim 14, Suzuki discloses a computer)fig. 1; col. 7, lines 21-23; & lines 44-53), comprising:

means for generating a plurality of commands describing a document, the commands including a named sequence describing a form (print job 10 and JDF in fig. 4) and at least one command indicating (RipFileSave 56) permission is granted to convert the named sequence once into video data (the already-expanded print jobs) and to then print each instance of the form from the video data (printing the print job from the already-expanded print jobs) or a command (JobSave 54) indicating new video data is to be generated to print each instance of the form (printing the print job from the newly rasterized print job); and

means for transmitting the plurality of commands to a printer (JDF in fig. 4).

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16. With respect to claim 18, Suzuki discloses the computer of claim 14, wherein the printer is responsive to the plurality of commands by printing the document (col. 11, lines 2-9).

17. With respect to claim 19, Suzuki discloses the computer of claim 14, wherein the printer is connected to the computer over a network (fig. 1).

18. With respect to claim 20, Suzuki discloses the computer of claim 14, wherein the plurality of commands forms a print job (figs. 2-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Shimuzu U.S. Patent No. 6,052,202.

19. With respect to claim 22, Suzuki discloses a printer, comprising:

an input/output port (acceptance module 76 and col. 9, line 67 – col. 10, line 5)
for receiving PDL print commands (fig. 1);

a control unit (system control module 74 in fig. 12) operatively connected to the
input/output port;

a print engine operatively connected to the control unit (printer 104); and

the control unit configured to respond to PDL print commands that include a named sequence describing a form and an indicator (print job 10 and JDF in fig. 4 & col. 12, lines 10-27) by (1) if the indicator indicates permission is granted to print each instance of the form from the same video data (RipFileSave 56), processing the named sequence according to a first printing algorithm (printing the print job from the already-expanded/rasterized print jobs), (2) if the indicator indicates each instance of the form is to be printed from new video data (JobSave 54), processing the named sequence according to a second printing algorithm (printing the print job from the newly rasterized print job), or (3) if the indicator indicates the form is a fixed form (print job hold option52 in fig. 4), processing the named sequence according to the second algorithm (holding the print job in the memory 80 thus the data is fixed in the memory in col. 10, lines 47-49). In cases of (2) and (3), unrasterized/unprocessed print data is stored in the data memory 80, thus both process the print job according to the second algorithm.

Suzuki, however, does not disclose the indicator indicating the form is a background image and processing the named sequence according to a third algorithm.

Shimizu, the same field of endeavor of the printing art, discloses a printer that receives print data (in a PDL format) from a host wherein the print data includes an indicator indicating that a form is a background image (col. 14, lines 9-12). Moreover, when the background attribute is detected, a new printing process is performed (col. 14, lines 29-53 & col. 15, lines 17-28).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the print data including background attribute indicator of Shimizu with the printer of Suzuki.

The suggestion/motivation for doing so would have been to properly include image or foreground image data in the background data when a user requests a combination of foreground and background image.

Therefore, it would have been obvious to combine Shimizu with Suzuki to obtain the invention as specified in claim 22.

20. With respect to claims 23 and 24, arguments analogous to those presented for claim 22, are applicable. Also, see fig. 4 (HoldTiming 52, JobSave 54 and RipFileSave 56 fields).

21. With respect to claim 25, arguments analogous to those presented for claim 22, are applicable.

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Conclusion


22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
March 4, 2005

Chan S. Park
Examiner
Art Unit 2622


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